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AF/1742

Attorney Docket 183-U.S.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Algirdas A. Underys)
)
Serial No.: 08/991,113)
)
Filing Date: December 16, 1997)
)
Title: Heat Treatment Method and)
 Apparatus)

Attention:

Primary Examiner
Wyszomierski

Group 1742

#3 ✓

The Honorable Commissioner
of Patents and Trademarks
Washington, DC 20231

ON APPEAL

Appeal No. 2001-0359

(Formerly: Appeal No. 10,359)

LETTER TRANSMITTING
APPLICANT'S REPLY BRIEF

We transmit herewith Applicant's Reply Brief in triplicate.

We call the Clerk of the Board of Patent Appeals and Interferences' attention to the fact that this application was initially appealed on or about June 28, 2000.

Over two years later, on July 18, 2002, the Board remanded the application to the Examiner to consider and act on a paper which, though appropriately filed by applicants, had not been entered.

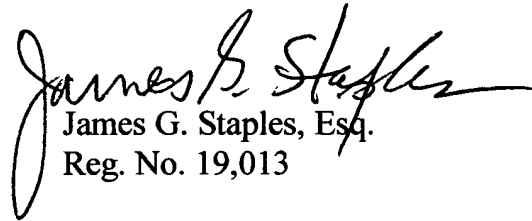
However, the application remained under rejection after consideration of said paper which overcame the appealed rejection, and applicant filed a renewed Notice of Appeal on or about March 17, 2003.

Reply Brief Noted
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It is therefore respectfully requested that the application be given the benefit of the June 28, 2000 date of the filing of the original Notice of Appeal (which is over two years ago) with respect to its priority standing for decision by the Board.

It is submitted that it would be unfair to applicant for this application to go to the bottom of the list awaiting consideration by the Board in view of the Office error in not entering said paper.

Respectfully submitted,


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09/05/03

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ON APPEAL

Appeal No. 2001-0359

(Formerly: Appeal No. 10,359)

APPELLANT'S REPLY BRIEF

The Examiner has acknowledged that this appealed application of Underys, filed December 16, 1997, is the earliest application relevant to the claims on appeal, and the Finkl-Underys application, which was filed 9-1/2 months later on September 15, 1998, and matured into the '885 patent, is the only other relevant application, Examiner's Answer, page 5, (hereafter "Answer").

With this in mind, and the doctrine that in obviousness type double patenting issues it is the relevant claims which must be analyzed to determine if an improper timewise extension of the patent grant is possible,¹ we now turn to the facts of this case.

¹ "...Double patenting is altogether a matter of what is claimed." General Foods Corp. v. Studiengesellschaft Kohle mbH, 23 USPQ2d 1839, 1843 (Fed. Cir. 1992).

For convenience we will refer to this earliest filed Underys infrared heat treating application as the Underys invention, and the later filed, now patented, Finkl-Underys shank conditioning application as the Finkl-Underys invention. Appealed claim 15 of the Underys invention and claim 1 of the patented Finkl-Underys invention will be compared since these are the broadest claims of each.²

By application of the holdings in In re Stanley et al., 102 USPO 234, CCPA, 1954; In re Borah, 148 USPO 213, CCPA, 1996; and In re Braat, 19 USPO 1289, CAFC, 1991, it is clear that no double patenting issue is present and the Office should not have required a terminal disclaimer in paper no. 27. Borah, supra, states the proposition which is determinative of this appeal, namely,

"that when a latter filed improvement patent issues before an earlier filed basic application, a double patenting rejection is only proper against the claims to the basic invention if the improvement is not patently distinct from the basic invention. The rationale behind this proposition is that an application (or applicants), who files applications for basic and improvement patents should not be penalized by the rate of progress through the PTO, a matter over which the applicant does not have

² We hesitate to characterize the claimed subject matter as "broad-specific" or "combination-sub-combination" since in our view they are quite different inventions even though each may have the feature of infrared heating, just as two mechanical patents may each include "fastening means" as a claimed feature.

complete control ... In this situation, the order of issuance is, in effect, ignored, and the relevant determination becomes whether the improvement is patentably distinct from the generic invention."

Applying these principles to the comparison claims -- appealed claim 15 and '885 patent claim 1 -- yields the following.

The common assignee could not have included claim 1 of the Finkl-Underys '885 patent in this appealed Underys application because Underys did not invent the subject matter of the Finkl-Underys patent claims, i.e., heating a small two inch deep portion of one flat face of a die block which had previously been heat treated to its final, hardened condition to a temperature above the temperature used in the final heat treating of the block so as to soften it whereby subsequent use in production would not cause a so-called fillet crack; see element "19" in the '885 patent.

Nor could the common assignee have included the appealed claim 15 in the Finkl-Underys application because Finkl-Underys did not invent the subject matter of the Underys claim 15, i.e., heat treating rod, bar and block tool steel workpieces in the interior of a furnace while maintaining the workpiece stationary.

While not essential to our position, we note that Finkl-Underys claim 1 is patentably distinct from the subject matter defined by claim 15 of Underys. Specifically Finkl-Underys claim 1 includes the limitations:

- a. starting the process with a pre-hardened (i.e.: already heat treated to its final

- hardness) die block;
- b. the die block having a shank portion and a working side, and a specific contour including flat planes;
 - c. the shank portion having a depth of about two inches;
 - d. treating the two inch shank portion to a temperature higher than the original heat treat temperature (whereby the final hardness in that two inch deep portion is destroyed);
 - e. exposing the non-shank portions to ambient atmosphere during treatment of the shank portion;
 - f. heating the shank portion for a length of time sufficient to soften the hardness of the shank portion to a value below the original starting value;
 - g. stopping treatment after said softness has been attained in a two inch deep portion of the shank portion;
 - h. to yield a two-hardness workpiece.

None of the aforesaid features or elements of '885's claim 1 can be found implicitly or explicitly in appealed claim 15.

Further, considering McGinty or Heath et al in conjunction with '885's claim 1 would not obviously suggest appealed claim 4, nor would McGinty in conjunction with '885's claim 1 have suggested appealed claim 19. The supplemental references are simply irrelevant.

In summary, the facts of this case, when judged against the holdings of Stanley et al, supra, Borah, supra, and Braat, supra, in all of whom the fact situations are on all fours with

this appeal, lead inexorably to the conclusion that the Office has not sustained its burden of establishing even a prima facie basis to deny patentability to a claimed invention.³

On page 6 of the Answer the Examiner states, in an attempt to explain away administrative delay in the PTO in this appealed application:

"More importantly, note that the Amendment filed by Appellant in March 2002 (Paper no. 23) successfully removed all grounds of rejection pending at that time, leaving only obviousness type double patenting rejections to be made. Had this amendment been filed at any time prior to a Notice of Allowability in the September 1998 application which matured into the '885 patent, no grounds of rejection would have been remaining and the present claims would have issued. The Notice of Allowability in the '885 patent issued in December 2001. Thus, if Appellant had submitted the amendment of March 2002 at any time during the nearly two-year period between December 1999 (when the original Notice of Appeal was filed in the present application) and December 2001 (when a Notice of Allowability was issued in the "later filed" application), no double patenting issue would have been raised, and no rejections would have been pending

³ See Ex parte Michno, 38 USPQ2d 1211, PTO BA1, 1993, footnote 4, which we have noted in our research but do not here cite as binding precedent.

with respect to the appealed claims." (Examiner's emphasis)

The lack of relevancy of this statement is apparent from the fact that the Examiner rendered no double patenting rejection in this application until August 5, 2002, following the remand, with opinion, from this Board in which the Board instructed the Examiner to consider entering an amendment duly filed, but misplaced by the PTO, of March 4, 2002 (which applicant had taken the initiative to file in an effort to cut short the long, in applicant's view), pendency of the initial appeal.

Specifically, the sole issue in the initial appeal was a 35 USC 112 rejection concerning wording of the appealed preamble of the claims. Applicant had no hint that a double patenting rejection was under consideration by the Examiner up to March 4, 2002, or that by substituting rod, bar and block for "bar, blocks and other" in the March 4, 2002 submission, the Examiner would then consider a double patenting rejection.

The '885 patent application was assigned to and pended in the same Group Art Unit as the instant appealed application. During the three month co-pendency of the allowed claims in the '885 patent application and the March 4, 2002 amendment in the instant application, (i.e.: March 4, 2002 - June 4, 2002) the Examiner in this application had the authority and obligation to render a provisional double patenting rejection of the '885 claims so that applicant herein could take appropriate action. Or, as 706.02(k), MPEP, 8th Ed, p. 700-32, puts it: "This gives applicant the opportunity to analyze the propriety of the rejection and possibly avoid the loss of rights to desired subject matter." But this was not done. Rather, with the 20-20 vision of hindsight, the Office now says that applicant should

have realized that by making an insignificant terminology revision to the preamble of the then pending claim (in an effort to conclude pendency short of prosecuting an appeal to a final conclusion), applicant had opened a whole new issue -- double patenting.

We call the Board's attention to the fact that all the relevant words and phrases in the appealed claims which could possibly be implicated in a double patenting context were before the Office since at least March 19, 1999 (believed to be Paper No. 4); that is, three years and one and one-half months before the '885 patent issued.

We submit this is an unreasonable position for the Office to take in support of its position.

The Examiner also noted that applicant filed a revival petition to cure a two and one-half month delay (September 27, 1999 - December 16, 1999). Since full compliance with 37CFR 1.137(b) established that the delay was unintentional, we understand the petition cured the delay in that under applicable law the application is deemed to have continuously pending, and no fault impacting the double patenting rejection should be attributable thereto. If we misstate the law we call the Board's attention to the fact that the instant application was filed nine and one-half months before the '885 application, so under any view of the facts most favorable to the Office, the present application preceded the '885 application by over seven months.

We submit that a reasonable mind reviewing the instant application file will appreciate that applicant made a strenuous effort to bring prosecution in this application to an early conclusion. Specifically, by our count, the Office entered a minimum of three

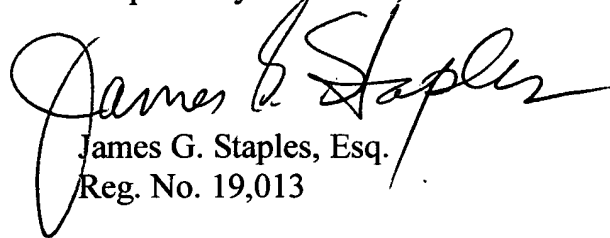
separate rejections (including the rejection here on appeal after the remand of the first appeal) and adhered to prior rendered rejections at least six times, all but the first of said rejections and adherences being rendered after timely efforts by applicant in the form of amendments, declarations prepared to overcome rejections and telephone conferences initiated by applicant to put all claims in allowable condition.

We respectfully submit that by any standard applicant must be deemed to have made a strenuous, good faith effort to conclude examination at the earliest possible date and no delay impacting the double patenting rejection can be attributed to applicant.

Conclusion

The requisite elements of an obviousness type double patenting rejection are not present in this appeal and the rejection should be reversed.

Respectfully submitted,


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